

### **REMARKS**

In this response to the Examiner's communication dated January 6, 2009, Applicants have combined the arguments from the office action response filed September 28, 2008, the first supplemental response filed on October 8, 2008, and the second supplemental response filed October 14, 2008. This communication is intended to fully address all of the rejections in the Office Action dated May 29, 2008. By way of this amendment, no new matter has been added.

Applicants have amended claims 1, 35 and 37, added new claims 38-40, and claim 36 has been cancelled. Claims 2-17, 19 and 21 were previously cancelled. Thus, claims 1, 18, 20, 22-35 and 37-40 remain pending in this application. At least for the reasons set forth below, Applicants respectfully traverse the foregoing rejections. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicants respectfully request reconsideration of the present application in view of the above amendment and the following remarks.

In view of the following arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

### **Claim Rejections Under 35 U.S.C. 103**

#### **1. The Law**

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish prima facie obviousness as follows: "To establish a prima facie case of obviousness, three

criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

“The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

*In re Oetiker* presents a test for analogous art as “whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor.” 24 USPQ2d, at 1445 (Fed. Cir. 1992). “In order to rely on a reference as a basis for rejection of the applicant’s invention, the reference must be either in the field of the applicant’s endeavor, or, if not, reasonably pertinent to the particular problem with which the inventor was concerned.” *Id.*

*In re Oetiker* provides that “[i]n order to rely on a reference as a basis for rejection of the applicant’s invention, the reference must be either in the field of the applicant’s endeavor, or, if not, reasonably pertinent to the particular problem with which the inventor was concerned.” 24 USPQ2d, at 1445 (Fed. Cir. 1992).

## **2. Claim Rejections**

Claims 1, 22-23, 25-26, 28, and 32-35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kateley (EP 0,278,607) in view of Noel (FR 2,816,802) in view of Praca (US 3,712,034). Applicants respectfully traverse the rejection.

### **3. Independent Claim 1**

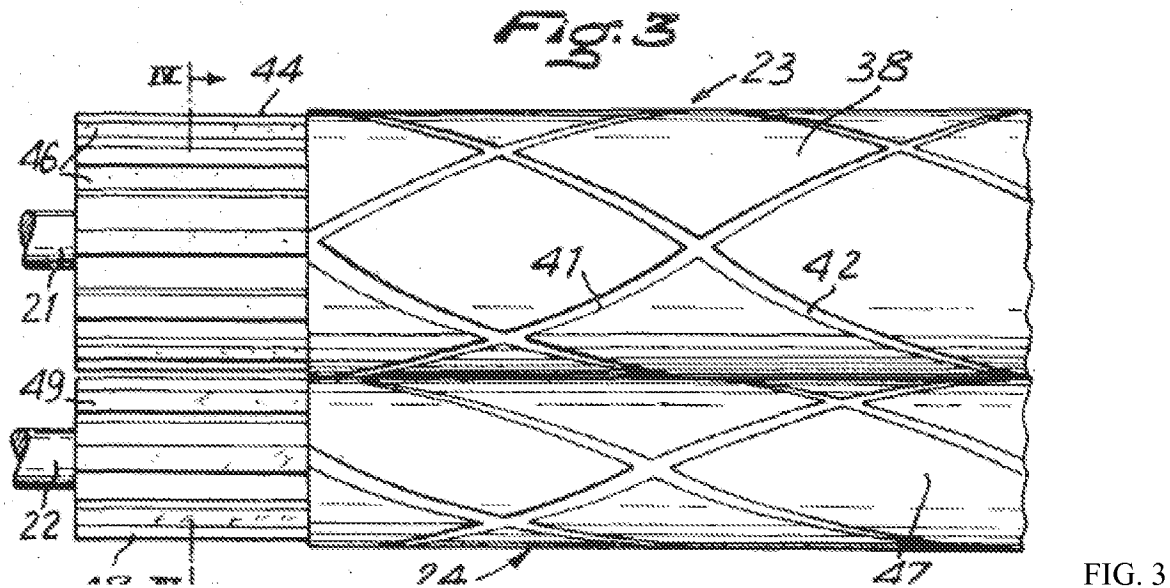
Independent claim 1 has been amended to include the recitation of “wherein the blower is configured for producing an air stream through the grooves for drawing leaves between the first rotatable cylinder and the second rotatable cylinder; wherein the leaves are selectively pressed between the first rotatable cylinder and the second rotatable cylinder in order to tear the leaves off plants,” (emphasis added). Support for these amendments may be found in the Applicants’ English translation in at least in at least page 4, lines 8-10 of the English Translation, as well as FIGs. 5a-5d.

#### **i. The Combination of Kateley, Noel and Praca Does Not Teach All Elements of Independent Claim 1**

The Examiner concedes that neither Kateley nor Noel disclose a first rotatable cylinder including includes peripheral grooves disposed circumferentially thereon, but that Praca discloses a similar roller 1 for a harvester, including helical grooves 41,” (*see Office Action, page 3*). Praca in no way compensates for the deficiencies of Kateley and Noel.

Praca teaches a hay conditioner for addressing the problem of “[w]hen a hay conditioner is placed directly behind a mower, the hay is not uniformly distributed . . . inasmuch as the two windrow boards each thrust the hay aside, with the result that the central portion of the crushing roll receives less material than the portions located near or at the ends,” (*see column 1, lines 10-21*). Applicants specifically draw attention to column 3, lines 46-52 and FIG. 3 of Praca (reproduced below for the Examiner’s convenience) to illustrate that Praca teaches a hay machine including two rolls 23 and 24 and a central portion 38 that is “provided with crossed helical grooves 41, 42 of very long pitch,” where “the hay can therefore engage within the grooves as it passes between the ends of the rolls, thereby permitting of uniform pressure over the full length of the rolls,” (*see column 4, lines 60-63*) (emphasis added). That is, Praca teaches a hay machine where hay will “engage within the grooves [41] as [the hay] passes between the ends of the rolls,” and does not teach or suggest that “wherein the leaves are selectively pressed between the first rotatable cylinder and the second rotatable cylinder in order to tear the leaves off plants.” To be clear, Praca actually **teaches away** from rolls 23 and 24 where “the leaves are selectively pressed between the first rotatable cylinder

and the second rotatable cylinder in order to tear the leaves off plants” because Praca actually teaches that the grooves 41 of the rolls 23 and 24 are for engaging with hay “as it passes between the ends of the rolls.” Thus, the combination of Kateley with Noel and Praca does not teach every recitation of independent claim 1 as required in *In re Vaeck*.



## ii. Kateley and Noel Are Incapable of Combination

Because Kateley teaches cutter for removing plant foliage using a rotary cutting blade for cutting plant foliage, while Noel teaches two rollers and pruning saw for stripping leaves, one would have not reasonably expected success in attempting to combine Kateley with Noel. In fact, Kateley with Noel are incapable of combination, as Kateley only teaches a fan 2 with cutting blades 8 that are enclosed within a housing 10 with an aperture 11 for allowing the foliage to enter the housing 10, (see column 2, lines 33-39) while Noel teaches two parallel rollers and a pruning saw 10 for stripping leaves (see English abstract). The Examiner has provided no explanation of how Kateley’s rotary cutting blade could be combined with Noel’s parallel rollers and pruning saw. Moreover, it is clear that Kateley could not be modified with Noel’s rollers, as Kateley teaches the “paddle fan 2 sucks in foliage through the aperture 11,” (see column 2, lines 40-41) whereas Noel teaches a deflecting shield 11 that is arranged behind the rotatable cylinders (*see FIG. 7, reproduced*

*below for the Examiner's convenience*). In other words, the paddle fan 2 of Kateley could not be combined with the rollers of Noel, because the shield 11 of Noel actually **teaches away** from a fan "suck[ing] in foliage."

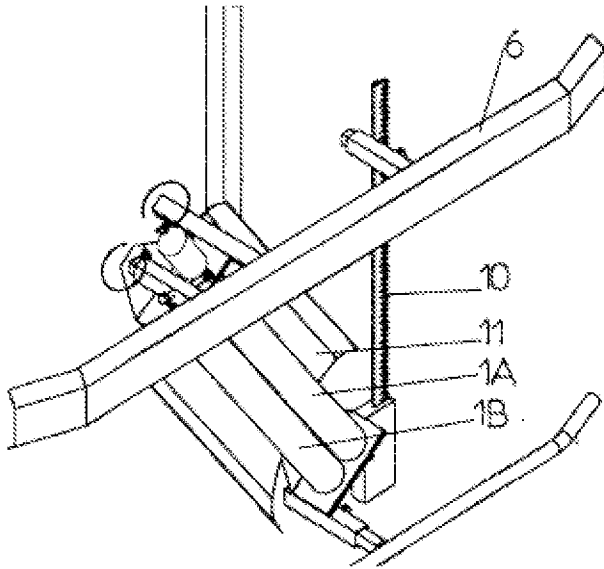


FIG. 7 of Noel

Moreover, even assuming that Kateley with Noel taught the claim recitations discussed above, which they do not, neither reference contains a motivation for combining Kateley with the teachings of Noel. Instead, one confronted with the same problem as the inventor would select only one of the cited references, since Kateley teaches a paddle fan 2 for sucking in foliage through the aperture 11, while Noel teaches a deflecting shield 11 that is arranged behind the rotatable cylinders. Thus, the references actually **teach away** from one another. Therefore, the Examiner has failed to establish a *prima facie* case for the combination Kateley and Noel, as required in *In re Gordon*.

### **iii. Praca is Non-Analogous Art**

Praca provides a hay conditioner for uniformly crushing hay, (*see column 4, lines 60-63*). Applicants were concerned with stripping the leaves of crops, (*Applicants' English Translation, page 3, first full paragraph*). Praca does not present a solution for stripping the leaves of a plant. Accordingly, Praca is not within the field of the Applicants' endeavor.

Additionally, Praca is not reasonably pertinent to the particular problem with which the inventor was concerned. As mentioned above, Praca teaches a hay conditioner for addressing the problem of when hay is not uniformly distributed during the crushing process. Accordingly, Praca is of no use when seeking to strip the leaves of crops.

**iv. Dependent Claims 22-23, 25-26, 28, and 32-34**

Dependent claims 22-23, 25-26, 28, and 32-34 are also patentable at least by being dependent on allowable base claim 1, although the claims include recitations that also define over the prior art of record. Merely by way of example, claim 2 recites “wherein the cylinders are designed so that foliage is separated from a plant, and fruits of the plant are not damaged,” which is not taught in the prior art of record. Accordingly, reconsideration and withdrawal of this rejection is therefore respectfully requested.

**4. Independent Claim 35**

Independent claim 35 has been amended to include the recitation of “wherein the cutout includes an incline along an edge of the cutout and the incline is configured for minimizing air flow towards the second rotatable cylinder,” (emphasis added). Support for these amendments may be found in at least page 6, lines 30-32 of the last paragraph, as well as FIGs. 1-2 of the specification.

**i. The Combination of Kateley, Noel and Praca Does Not Teach All Elements of Independent Claim 35**

The Examiner asserts that Kateley teaches a cover plate “arranged on a side facing the foliage that has a cutout with an entry incline for the foliage,” (*see Office Action, page 6*). However, Applicants specifically draw attention to column 2, lines 52-55 and FIG. 2 (reproduced below for the Examiner’s convenience) of Kateley to demonstrate Kateley only teaches a “guide plate 5 . . . to partially align the plant material with the cutting apparatus in advance of it as the cutter moves along the foliage to be cut.” That is, as seen in FIG. 2, Kateley only teaches a guide plate 5 that is used to “align the plant material with the cutting apparatus” and does not teach or suggest that the guide plate 5 be located “along an edge of the cutout.” Moreover, Kateley does not

teach or suggest that the guide plate 5 is for “minimizing air flow towards the second rotatable cylinder.” Thus, the combination of Kateley with Noel and Praca does not teach every recitation of independent claim 35 as required in *In re Vaeck*.

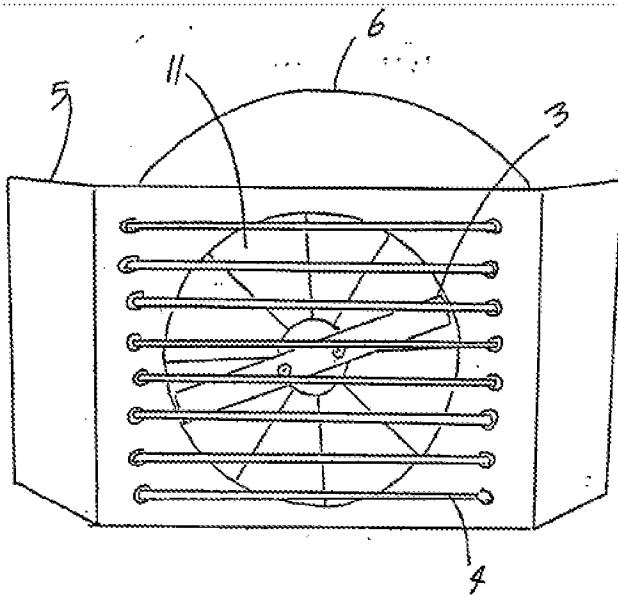


FIG. 2 of Kateley

### 5. Independent Claim 36

Independent claim 36 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kateley (EP 0,278,607) in view of Noel (FR 2,816,802) in view of Praca (US 3,712,034). However, this rejection is moot because claim 36 has been cancelled. Accordingly, withdrawal of the rejection is therefore respectfully requested.

### 6. The Combination of Kateley, Noel and Praca Does Not Teach All Elements of Dependent Claims 37 and 38

Dependent claim 37 has been amended to be dependent on claim 35, and to include the recitation of a “first rotatable cylinder is made from a plastic so as to have a hydrophobic surface configured for reducing leaf crush between the hydrophobic peripheral surface and the second rotatable cylinder.” New claim 38 includes the recitation of “the second rotatable cylinder includes an elastic peripheral surface configured for reducing leaf crush between the elastic peripheral

surface and the first rotatable cylinder,” (emphasis added). Support for these recitations may be found in at least page 6, lines 23-24, and page 7, lines 1-2 of the English translation.

Dependent claims 37-38 are patentable at least by being dependent on allowable base claim 35, although the claims include recitations that also define over the prior art of record. For example, the Examiner asserts that Praca teaches “the first rotatable cylinder is made from a plastic so as to have a hydrophobic surface. . . Praca teaches a similar cylinder (roll 23) for harvesting wherein a portion (44) of the cylinder is made from a plastic having good qualities of adhesion, even under moist working conditions,” (*see Office Action, page 3*). However, Kateley only teaches that the two rolls 23 and 24 only have “good qualities of adhesion, even under moist working conditions,” (*see column 3, lines 52-55*). The Examiner mistakenly suggests that having “good qualities of adhesion, even under moist working conditions” somehow translates into having a “hydrophobic peripheral surface.” As a related example of material terminology, Sematech defines hydrophobic as “having little affinity for water; nonwetable,” (*see <http://ismi.sematech.org/publications/dictionary/h.htm>*). However, Praca does not teach or suggest that the rolls 23 and 24 include a “hydrophobic” or a “nonwetable” surface.

Moreover, Praca actually **teaches away** from rolls 23 and 24 “configured for reducing leaf crush.” Indeed, as discussed above, Praca actually teaches to apply “uniform pressure over the full length of the rolls” for the purpose of cracking hay (*see column 4, lines 47-63*), and therefore teaches away from first and second rotatable cylinders “configured for reducing leaf crush.” Thus, the combination of Kateley with Noel and Praca does not teach every recitation of dependent claims 37-38 as required in *In re Vaeck*.

## **7. New Dependent Claim 39**

New claim 39 includes the recitation of “wherein the incline is located at a rearward edge of the cutout with respect to the working direction of the leaf stripping device, and is angled towards the second cylinder,” (emphasis added). Support for these recitations may be found in FIGs. 1-2.



Dependent claim 39 is patentable at least by being dependent on allowable base claim 35, although the claim includes recitations that also define over the prior art of record. As discussed above, Kateley only teaches a “guide plate 5 . . . to partially align the plant material with the cutting apparatus in advance of it as the cutter moves along the foliage to be cut,” (*see column 2, lines 52-55*) (emphasis added). That is, as seen in FIG. 2 (reproduced above for the Examiner’s convenience), Kateley only teaches a guide plate 5 that is used to “align the plant material with the cutting apparatus” in “advance of” the cutting apparatus, and actually **teaches away** from the guide plate 5 “located at a rearward edge of the cutout with respect to the working direction of the leaf stripping device.” In other words, the guide plate 5 of Kateley is incapable of being placed on the “rearward edge of the cutout with respect to the working direction of the leaf stripping device” because Kateley teaches aligning the plant material “in advance of” the cutting apparatus. Thus, the combination of Kateley with Noel and Praca does not teach every recitation of dependent claim 39 as required in *In re Vaeck*.

#### **8. New Dependent Claim 40**

New claim 40 includes the recitation of “wherein the grooves are configured for selectively trapping other objects from being suctioned into the air stream,” (emphasis added). Support for these recitations may be found in at least page 7 in the first full paragraph, as well as FIGs. 1 and 5a-5d of the specification.

Dependent claim 40 is patentable at least by being dependent on allowable base claim 1, although the claim includes recitations that also define over the prior art of record. As discussed above, Praca only teaches a hay machine where hay will “engage within the grooves [41] as [the hay] passes between the ends of the rolls,” (*see column 4, lines 60-63*) (emphasis added) and does not teach or suggest that the grooves 41 are for “selectively trapping other objects from being suctioned into the air stream.” To be clear, Praca does not teach where “the leaves are selectively pressed between the first rotatable cylinder and the second rotatable cylinder in order to tear the leaves off plants” because Praca actually teaches that the grooves 41 of the rolls 23 and 24 are for

engaging with the hay. Thus, the combination of Kateley with Noel and Praca does not teach every recitation of dependent claim 40 as required in *In re Vaeck*.

### **9. Dependent Claims 18, 24, and 29-31**

Claims 18, 24, and 29-31 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kateley ('607) in view of Noel ('802) in view of Praca ('034) as applied to claim 1 above, and further in view of Bou (FR 2,417,932).

Claims 18, 24, and 29-31 depend from claim 1. The remarks presented above with respect to the rejection based on Kateley ('607) in view of Noel ('802) in view of Praca are equally applicable here. Specifically, the inadequacy of Bou to teach every element of independent claim 1 by not teaching "wherein the leaves are selectively pressed between the first rotatable cylinder and the second rotatable cylinder in order to tear the leaves off plants," is also fatal to the Examiner's rejection in view of Bou. Bou does not make up for the inadequacy described above in Praca. Therefore, the combination of Kateley, Noel, Praca and Bou does not teach every recitation of claim 1, as required in *In re Royka*.

### **10. Dependent Claim 27**

Claim 27 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kateley ('607) in view of Noel ('802) in view of Praca ('034) as applied to claim 1 above, and further in view of Pelene et al. (WO 01/87047).

Claim 27 depends from claim 1. The remarks presented above with respect to the rejection based on Kateley ('607) in view of Noel ('802) in view of Praca are equally applicable here. Specifically, the inadequacy of Pelene to teach every element of independent claim 1 by not teaching "wherein the leaves are selectively pressed between the first rotatable cylinder and the second rotatable cylinder in order to tear the leaves off plants," is also fatal to the Examiner's rejection in view of Pelene. Pelene does not make up for the inadequacy described above in Praca. Therefore, the combination of Kateley, Noel, Praca and Pelene does not teach every recitation of claim 1, as required in *In re Royka*.

**CONCLUSION**

Reconsideration and allowance of the claims as now presented are respectfully requested. In view of the above amendment and remarks, applicant believes the pending application is in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 66795-0001 from which the undersigned is authorized to draw.

Dated: February 5, 2009

Respectfully submitted,

By: /Michael B. Stewart/  
Michael B. Stewart

Registration No.: 36,018  
RADER, FISHMAN & GRAUER PLLC  
Correspondence Customer Number: 10291  
Attorney for Applicant